

Dennis R. Sigl

S/N: 10/065,773

**REMARKS**

Claims 1-22 are pending in the present application. In the Final Office Action mailed September 20, 2005, the Examiner rejected claims 1, 2, 5, and 8 under 35 U.S.C. §102(e) as being anticipated by Kataoka (JP 08-203754). The Examiner next rejected claims 3, 4, 21, and 22 under 35 U.S.C. §103(a) as being unpatentable over Kataoka in view of Nakano (JP 55-105301). Claims 6, 9-13, 15, 16, and 18-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kataoka in view of Nakano and Tobben et al. (USP 4,596,974). Claims 7, 14, and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kataoka, in view of Leuck et al. (USP 3,665,358). Claims 9-12 and 15, are rejected under 35 U.S.C. §103(a) as being unpatentable over Tobben et al. (USP 4,596,974).

**Finality of Action:**

In the Office Action of April 7, 2005, the first action in the above captioned matter applying Kataoka (JP 08-203754) and Nakano (JP 55-105301), the Examiner rejected each of the claims of the present application as unpatentable over Japanese patent references Kataoka (JP 08-203754) and/or Nakano (JP 55-105301). MPEP §706.02.11 requires that "[i]f the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection." (Emphasis added). The Office Action did not include a translation of the documents relied upon. Accordingly, not knowing what the reference states about the Figures, Applicant was unable to fully respond to the Examiner's assertions. Without a translation of the document, rejections relying on anything more than the translated abstract thereof are improper. Applicant must be given an opportunity to respond. The converse is equally true – if Applicant submits a foreign language reference for consideration, the Applicant has the burden of supplying a translation for full consideration. If the Examiner uses a foreign language document, the Examiner must supply a translation as well and give Applicant an opportunity to respond.

Although the Examiner has provided a translation of Kataoka (JP 08-203754) with the Final Office Action of September 20, 2005, the Examiner has yet to provide a

Dennis R. Sigl

S/N: 10/065,773

translation of Nakano (JP 55-105301). The Examiner has provided a translation of only one of the foreign references used to reject the claims and the Examiner has done so in a final office action. As stated in MPEP §706.07, "Before a final action is in order, a clear issue should be developed between the examiner and applicant." MPEP §2271 further states that "[t]o bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final." MPEP §706.07 further states that "present practice does not sanction hasty and ill-considered final rejections" and "[t]he applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application." MPEP §706.02.II requires a translation of a foreign language document that is relied upon by the examiner in a non-final action to allow an applicant an opportunity to respond.

Furthermore, in the Office Action of September 20, 2005, the Examiner states that "claims 9-12 and 15, as best understood in view of the rejection under 35 U.S.C. §112, second paragraph..." are rejected as unpatentable over Toben et al. [sic]. However, the Examiner has not presented a rejection of these claims under 35 U.S.C. §112, second paragraph. As such, minimally, the Office Action is unclear whether claims 9-12 and 15 stand rejected under 35 U.S.C. §112, second paragraph.

For all the reasons set forth above, Applicant believes that the finality of the currently pending Office Action of September 20, 2005 is clearly premature. As such, Applicant requests that the finality of the outstanding Office Action be withdrawn as improper and that a subsequent non-final action with a translation of Nakano (JP 55-105301) be provided to allow Applicant an opportunity to respond to that which the Examiner alleges is shown or disclosed therein.

**Rejection of Claims Over the Art of Record:**

The Examiner rejected claim 1 under 35 U.S.C. §102(e) as being anticipated by Kataoka. Applicant has amended claim 1 to further define that which is called for

Dennis R. Sigl

S/N: 10/065,773

therein. Claim 1 calls for, in part, a bobbin for an inductor assembly having a molded body with a single flange centrally disposed thereon wherein the single flange has a pair of faces wherein at least one of the pair of faces is generally non-planar.

As stated in MPEP §2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” As shown in Figs 13 and 14 of the translation of Kataoka, bobbin 2 includes a flange 6 that intersects the ends of the pair of cores 7. As shown in Fig. 14, flange 6c includes a pair of substantially planar faces. That is, the flanges of the Kataoka do not include a pair of faces wherein at least one of the faces is generally non-planar as called for in claim 1. Accordingly, that which is called for in claim 1 is not disclosed in Kataoka. Furthermore, rather than modifying the structure of the bobbin to include a non-planar faced spacer as called for in the present invention, Kataoka solves the problem of core spacing by providing spacers which are separate from the Bobbin. That is, Kataoka states the inductor bobbins which have integral spacers suffer from poor working efficiencies. Kataoka translation ¶[0010]. Kataoka further states that “this invention was made in view of the trouble of all above [, including that which is shown in Figs. 13 and 14,] and is made into the purpose consists of a core, a bobbin, and 3 individual objects of a spacer.” Id. at ¶[0011]. That is, rather than changing the construction of the flange which forms the spacer, Kataoka provides separate spacers. Accordingly, Kataoka does not disclose, teach, or suggest providing a non-planar flange as called for in claim 1. As such, Applicant believes that which is called for in claim 1, and the claims which depend therefrom, is patentably distinct over Kataoka.

The Examiner next rejected claim 21 under 35 U.S.C. §103(a) as being unpatentable over Kataoka in view of Nakano. Again, in setting forth the rejection, the Examiner has relied on more than the translated abstract of Nakano and has referenced Applicant’s attention to part numbers disclosed therein. In accordance with MPEP §706.02.II, the Examiner must (1) provide a translation thereof and (2) afford Applicant an opportunity to respond thereto.

Applicant has amended claim 21 to clarify that which is called for therein. Claim 21 calls for, in part, a bobbin for an inductor assembly having a single flange wherein the

Dennis R. Sigl

S/N: 10/065,773

single flange includes a pair of ends and at least one face of each end has an embossed surface defining a portion of a uniform gap between a pair of ferrite cores. As previously argued with respect to claim 1, Kataoka teaches a generally planar flange and teaches providing a flange that is removeably engageable with the inductor assembly. That is, Kataoka teaches away from providing a flange with an embossed surface as compared to providing a removable flange as disclosed in Kataoka.

Applicant does not necessarily disagree that Nakano discloses a flange that has a generally non-planar face. Nakano discloses "a spacer 6 having an enveloping fringe 6a is formed previously on a coil bobbin." Translated Constitution. That is, that portion of flange 6 disposed between the ends of the cores is generally planar and a fringe extends about the generally planar spacer portion of the flange. Nakano further states that "[b]y enveloping fringe 6a of spacer 6, the insulation is improved and the location of the core 1 and the spacer 6 can easily be determined." *Id.* That is, as shown in Fig. 2 of Nakano, the fringe 6a of the flange of the bobbin 2 generally surrounds a core end that is positioned thereagainst. The spacer, or the portion of the flange which maintains the separation between the ends of the cores is substantially planar. The raised portion of the flange of Nakano does not define a portion of the gap between the core ends as called for in claim 21. Additionally, rather than replacing the centrally located planar flange of Kataoka with a flange having an embossed surface as called for in claim 21, Kataoka teaches providing a separate planar spacer element. Accordingly, not only does the art of record fail to teach or suggest each and every element as called for in the claims, the Examiner's combination of that which is shown therein appears to be the result of the insidious effect of the "impermissible hindsight syndrome." As stated in MPEP §2145, "[i]t is improper to combine references where the references teach away from their combination." Accordingly, for all the reasons set forth above, Applicant believes that which is called for in claim 21, and those claims which depend therefrom, is patentably distinct over the art of record.

The Examiner next rejected claim 9 under 35 U.S.C. §103(a) as unpatentable over Kataoka, in view of Nakano and Tobben et al. Applicant respectfully disagrees.

Dennis R. Sigl

S/N: 10/065,773

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. MPEP §2142. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. To establish a *prima facie* case, the Examiner must not only show that the combination includes each and every element of the claimed invention, but also provide "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). "The fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness." MPEP § 2143.01. When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Claim 9 calls for, in part, a bobbin having an embossed flange to maintain a constant gap between the pair of ferrite cores. As previously argued with respect to claim 21, neither Kataoka nor Nakano teaches, suggests, or discloses an embossed flange to maintain a constant gap between the pair of ferrite cores. In fact, Kataoka teaches away from such a construction in stating that a spacer element separate from the bobbin provides uniform core spacing. Additionally, the non-planar surface of Nakano does not maintain a constant gap between the pair of ferrite cores. The only portion of the spacer of Nakano that is positioned between the ends of the cores is substantially planar. The raised portion of the flange of Nakano is outside the engagement of the ends of the cores, or positioned about the "fringe" of the cores and does not maintain a constant gap between the pair of ferrite cores as called for in claim 9.

Claim 9 further calls for a pair of securing devices oriented transversely to the pair of ferrite cores to secure the pair of ferrite cores to the plastic bobbin. The Examiner maintains that, even though the art of record does not teach or suggest such a pair of securing devices, "[t]he specific orientation of the spring clips would have been an

Dennis R. Sigl

S/N: 10/065,773

obvious choice since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein, 8 USPQ 167." This is a verbatim recitation of the rejection proffered in the previous Office Action. Applicant respectfully requests that the Examiner address Applicant's remarks with respect to this assertion.

MPEP §2144.04.VI.C states that "[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims ... is not by itself sufficient to support a finding of obviousness." MPEP §2144.04.VI.C further states that "[t]he prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." Citing Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). (Emphasis added). As shown in Fig. 3 of Tobben et al., rotating clip 67 such that the clip is transverse to core 55 would result in the non-engagement of the apertures 63 of clip 67 with the projections 65 of coil former 1,3. Additionally, such an orientation would result in one of rectangular ends 61 of clip 67 interfering with connection pins 29 of the device. That is, the Examiner's suggested combination would result in an assembly wherein the spring clip does not secure the core to the coil former and an assembly wherein the spring clip interferes with the connection of the coil former to an electrical component. As such, a person of ordinary skill in the art would readily appreciate that the combination suggested by the Examiner would render the assemblies of Kataoka, Nakano, and Tobben et al. unsuitable for their intended purpose. That is, the assembly suggested by the Examiner would not secure the cores to the assembly and would interfere with the connection of the device with an electrical system. For all of the reasons set forth above, claim 9 is believed to patentably define over the art of record.

The Examiner also rejected claim 16 under 35 U.S.C. §103(a) over Kataoka in view of Nakano and Tobben et al. Applicant has amended claim 16 to clarify that which is called for therein. Claim 16 calls for a bobbin having a centrally positioned flange configured to engage opposing faces of a pair of ferrite cores to maintain a uniform separation between the pair of the ferrite cores. Claim 16 further calls for the flange to have a maximum thickness that is no greater than a distance of the uniform separation.

Dennis R. Sigl

S/N: 10/065,773

That portion of the bobbins of Kataoka and Tobben et al. constructed to engage the faces of the cores are substantially planar. That portion of the spacer of Nakano which engages the end of the core is also substantially planar. As shown in Fig. 2 of Nakano, a portion of the spacer extends beyond the face of the core and generally extends thereabout. That is, the spacer does not have a maximum thickness that is no greater than a distance of the uniform separation as called for in claim 16. Accordingly, that which is called for in claim 16 is not taught, shown, or suggested in the art of record. As such, Applicant believes claim 16, and the claims that depend therefrom, are patentably distinct over the art of record.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-4 and 6-22.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



Kirk L. Deheck  
Registration No. 55,782  
Phone 262-376-5170 ext. 16  
kld@zpspatents.com

Dated: November 21, 2005  
Attorney Docket No.: ITW7510.027

**P.O. ADDRESS:**  
Ziolkowski Patent Solutions Group, SC  
14135 North Cedarburg Road  
Mequon, WI 53097-1416  
262-376-5170